

REMARKS

This paper is presented in response to the Office Action. Claim 16 is canceled and claim 9 is amended. Claims 1-3 and 5-14 are now pending in view of the aforementioned cancellation.

Reconsideration of the application is respectfully requested in view of the following remarks. For the convenience and reference of the Examiner, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicants note that the remarks presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicants, of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner, and/or the merits of additional or alternative arguments.

II. Claim Rejections under 35 U.S.C. § 103

Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP § 2143*.

a. claims 1-3, 5, 7 and 8

The Examiner has rejected claims 1-3, 5, 7, and 8 as being unpatentable over US Patent No. 6,909,848 to Kim et al. (“*Kim*”) in view of US Patent No. 6,631,144 to Johansen et al. (“*Johansen*”) and further in view of U.S. Patent No. 6,272,154 to Bala et al. (“*Bala*”). Applicants respectfully disagree and submit that, for at least the reasons set forth below, the rejection should be withdrawn.

Claim 1 recites, among other things: “a controller coupled to the data rate select input and configured to . . . cease to adjust [a] selectable data rate once all selectable data rates have been attempted, whether or not [a] loss of lock signal has ceased.” The Examiner has conceded that *Kim* and *Johansen* fail to disclose the aforementioned limitation, but has alleged that that “such a limitation is known in the art.” *See* Office Action, p. 3. In support of this allegation, the Examiner has asserted that: “*Bala* teaches that if the digital signals are at data rates other than OC-48, OC-12, or OC-3 and also less than 2.5 Gb/s, said signals can bypass the network element and thereby the CDR circuitry.” *See* Office Action, p. 4 (citing *Bala* at col. 10, ll. 54-60).

Notwithstanding this allegation, it seems clear that the characterization of *Bala* advanced by the Examiner fails to support the stated rejection. Applicant notes at the outset that, in contrast with the plain language of claim 1, the portion of *Bala* cited by the Examiner makes no reference to any relationship between “selectable data rates” and a “loss of lock signal” and, in fact, that passage makes no reference at all to a “loss of lock signal” such as is recited in claim 1.

In fact, and as characterized by the Examiner, the cited passage of *Bala* discloses nothing more than that data signals of certain rates can bypass the CDR circuitry. More specifically, the cited passage of *Bala* provides only: that the “...WADM network element shall be able to ... bypass CDR circuits ... to allow data signals at other data rates...”; and, that “...digital signals at data rates other than OC-48, OC-12 or IC-3 (but less than 2.5 Gb/s) can be added, dropped or passed by the network element...” Contrary to the assertion of the Examiner, nowhere does the cited passage of *Bala* disclose how or when data rates will be considered and selected for passage through, or around, a CDR.

It thus seems clear that notwithstanding the contentions of the Examiner, the aforementioned passage of *Bala* fails to make any reference whatsoever to any sort of data rate adjustment methodology, much less disclose the specific process recited in claim 1, namely, “[ceasing] to adjust the selectable data rate once all selectable data rates have been attempted.”

In light of the foregoing discussion, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 1, at least because the Examiner has not established that the references, when combined in the purportedly obvious fashion, teach or suggest all the limitations of the rejected claims. Accordingly, the rejection of claim 1 should be withdrawn. By

virtue of their dependence from claim 1, claims 2, 3, 5, 7 and 8 include all the limitations of claim 1 and the rejection of those claims is thus defective for at least the reasons set forth above in connection with the discussion of claim 1. Applicant accordingly submits that the rejection of dependent claims 2, 3, 5, 7 and 8, should likewise be withdrawn.

b. claim 6

The Examiner has rejected claim 6 as being unpatentable over the combination of *Kim, Johansen, and Bala*, and further in view of U.S. Pre-Grant Pub. No. 2002/0060824 to Liou et al. (“*Liou*”). Applicants respectfully disagree.

Inasmuch as the rejection of claim 1, from which claim 6 depends, is defective for at least the reasons set forth above, the rejection of claim 6 likewise lacks an adequate foundation and should accordingly be withdrawn.

c. claims 9, 12-14¹ and 16

The Examiner has rejected claims 9, 12-14 and 16 as being obvious over *Johansen* in view of US Pub. 2002/0060824 to Kato et al. (“*Kato*”). Applicants respectfully disagree and submit that, for at least the reasons set forth below, the rejection should be withdrawn. Inasmuch as claim 16 is canceled herein, the rejection of that claim is moot and should accordingly be withdrawn.

Among other things, claim 9 recites a “transmit circuit” configured to “set the operational data rate of [an] optoelectronic device to successive data rates . . . until one of the following occurs: [a] loss of lock signal . . . ceases; or, each data rate . . . has been set.” As to this limitation, the Examiner has asserted that *Johansen* discloses “[a] transmit circuit being configured to set the operational data rate of the optoelectronic device to successive data rates (column 17, lines 43-50) (nominal bit rate of 2.5 Gb/s [that] can be controlled to be a higher or lower bit rate) included in the plurality of automatically selectable data rates until the loss of lock signal asserted by the receive circuit ceases ((columns 17-18 lines 63-67 and 1-12...”

Notwithstanding the characterization advanced by the Examiner, Applicant notes at the outset that the Examiner has failed to specifically identify the portion(s) of *Johansen* believed by the Examiner to correspond to the claimed “transmit circuit.” *Emphasis added*. Moreover, it is clear in any event that the passages of *Johansen* upon which the Examiner has relied refer, in fact, to a “receiving part.” *Emphasis added*. For example, the circuit denoted with reference numeral “410” (see Figure 2) at col. 17, lines 43-50 (relied upon by the Examiner) is not, contrary to the assertion of the Examiner, part of a

¹ The Office Action purports to reject claim 14 on page 6 (¶ 4) and again on page 9 (¶ 6). However, the mention of claim 14 on page 6 appears to be a typographical error because ¶ 4 does not set forth any grounds of rejection with respect to claim 14. In the event Applicants’ understanding of this matter is mistaken, clarification is respectfully requested.

transmit circuit, but rather a part of a receive circuit. In this regard, *Johansen* notes that “Fig. 2 shows in more detail the receiving chip 100 of Fig. 1.” *Col. 16, lines 45-46. Emphasis added.* Likewise, the circuits denoted respectively with reference numerals 425 and 530 (see Figure 2) at col. 17-18 lines 63-67 and 1-12 (also relied upon by the Examiner) are also elements of the “receiving chip 100.”

With the foregoing points in view, Applicant respectfully submits that it is clear that the reliance of the Examiner on the above-referenced portions of *Johansen* as disclosing elements of a “transmit circuit” is misplaced. Moreover, the Examiner has failed to establish that the “transmitting part” referred to in *Johansen* teaches or suggests all the limitations of the claimed “transmit circuit.”

In light of the foregoing discussion, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 9, at least because the Examiner has not established that the references, when combined in the purportedly obvious fashion, teach or suggest all the limitations of the rejected claims. Accordingly, the rejection of claim 9 should be withdrawn. By virtue of their dependence from claim 9, claims 12-13 include all the limitations of claim 9 and the rejection of those claims is thus defective for at least the reasons set forth above in connection with the discussion of claim 9. Applicant accordingly submits that the rejection of dependent claims 12-13 should likewise be withdrawn.

d. claims 10 and 11

The Examiner has rejected claims 10 and 11 as being obvious over *Johansen* in view of *Kato* and further in view of *Liou*. Applicants respectfully disagree.

Inasmuch as the rejection of claim 9, from which claims 10 and 11 depend, is defective for at least the reasons set forth above, the rejection of claims 10 and 11 likewise lacks an adequate foundation and should accordingly be withdrawn.

e. claim 14

The Examiner has rejected claim 14 as being unpatentable over *Johansen* in view of *Kato* and further in view of *Bala*. Applicants respectfully disagree and submit that, for at least the reasons set forth below, the rejection should be withdrawn.

Claim 14 recites a method comprising, among other things: “setting a bypass if all automatically selectable data rates in [a] range have been set without causing deassertion of [a] loss of lock signal.” The Examiner has conceded that *Johansen* and *Kato* fail to disclose the aforementioned limitation, but goes on to allege that “such a limitation is known in the art.” *See Office Action, p. 11.* To support this assertion, the Examiner alleged: “*Bala* teaches that if the digital signals are at data rates other than OC-48, OC-12, or OC-3 and also less than 2.5 Gb/s, said signals can bypass the network element and thereby the CDR circuitry.” *See Office Action, p. 11* (citing *Bala* at col. 10, ll. 54-60).

Notwithstanding these allegations, it seems clear that the characterization of *Bala* advanced by the Examiner fails to support the stated rejection. In particular, Applicant notes that, in contrast with the plain language of claim 14, the portions of *Bala* cited by the Examiner makes no reference to “setting a bypass,” “automatically selectable data rates” or deassertion of a “loss of lock signal,” much less to “...setting a bypass if all automatically selectable data rates in [a] range have been set without causing deassertion of [a] loss of lock signal.” as claim 14 requires. In fact, and as characterized by the Examiner, the cited portions of *Bala* disclose nothing more than that data signals of certain rates can bypass the CDR circuitry.

In light of the foregoing discussion, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 14, at least because the Examiner has not established that the references, when combined, teach or suggest all the limitations of the rejected claims. Accordingly, the rejection of claim 14 should be withdrawn.

CONCLUSION

In view of the remarks submitted herein, Applicants respectfully submit that each of the pending claims 1-3 and 5-14 in this application is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 27th day of February 2007.

Respectfully submitted,

/Peter F. Malen, Jr./

Peter F. Malen Jr.
Attorney for Applicant
Registration No. 45,576
Customer No. 022913
Telephone: (801) 533-9800